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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,269	08/31/2006	Holger Ceskutti	10191/4078	2994
26646 7590 11/13/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
STEVENS, THOMAS H				
ART UNIT		PAPER NUMBER		
2121				
MAIL DATE		DELIVERY MODE		
11/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/554,269

**Applicant(s)**

CESKUTTI, HOLGER

**Examiner**

THOMAS H. STEVENS

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-9, 15, 17 and 18 were cancelled.
2. Claims 10-14 and 16 were examined.

***Section I: Non Final Rejection***

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10-14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis et al (US Patent 7,000,115; hereafter Lewis). Lewis discloses a smart chip protection system (abstract).

Claim 10. A device for programming a controller, (control program, column 8, line 13) comprising: a portable, copy-protected plug-in memory unit (example of smart card technology , column 2, lines 30-35)for storing software, wherein the copy-protected plug-in memory unit (example of smart card technology , column 2, lines 30-35)is configured to transport software (software interaction with smart

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chip, column 5, lines 48-51) in an encrypted (column 4, lines 9-13) form from a hardware device (e.g., smart chip, column 22, line 31) to the controller (column 22, line 29).

Claim 11. The device according to claim 10, wherein the copy-protected plug-in memory unit (example of smart card technology, column 2, lines 30-35) includes at least one interface for receiving software from the hardware device and for transferring software (software interaction with smart chip, column 22, lines 15-35) to the controller (control program, column 8, line 13).

Claim 12. The device according to claim 10, wherein the copy-protected plug-in memory unit (example of smart card technology, column 2, lines 30-35) includes: an interface, manipulation-protected hardware, a cryptographic unit, at least one processor having logic (digital data is a bi-product of the digital logic, column 2, lines 58-62) and interface drivers, and a memory containing encrypted (column 4, lines 9-13) software, which includes controller software, programming software, (control program, column 8, line 13) and an encryption (column 4, lines 9-13).

Claim 13. The device according to claim 10, wherein the device is used for programming a controller (control program, column 8, line 13) of a motor vehicle (column 22, line 17).

Claim 14. A method for programming a controller, comprising: transferring software from a hardware device to a copy-protected plug-in memory unit (example of smart card technology, column 2, lines 30-35) storing the software in

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an encrypted form in the copy-protected plug-in memory unit(example of smart card technology , column 2, lines 30-35); and transferring the software stored in the copy-protected plug-in memory unit (example of smart card technology , column 2, lines 30-35)to the controller.

Claim 16. The method according to claim 14, wherein the method is for programming a controller of a motor vehicle(control program, column 8, line 13).

## ***Section II: Response to Arguments***

### ***Drawings***

5. Objection is withdrawn.

### ***101/102/103***

6. Rejections are withdrawn. However based on a revamped search produced another rejection as set forth above.

### ***Conclusion***

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7. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure:

- US 5787367A discloses a system and method for providing secured programming for reprogramming on-board vehicle computer systems.
- US 6944766 discloses an information terminal selects an input output device for user authentication in accordance with a user profile of a smart card and customizes a screen for the user authentication. In the smart card, information for selecting the input output device or customizing the screen is stored in a layer of a security level 0, and a key for accessing to an application such as electronic money, medical services, or the like is stored in a layer of a security level 1.
- US 6754349B1 discloses a computer system (4a), can be stored under password protection on a storage medium for insertion into the computer system as required. If the password is forgotten, or the storage medium is faulty, the secret material will not be accessible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Tom Stevens whose telephone number is 571-272-3715.

If attempts to reach the examiner by telephone are unsuccessful, please contact examiner's supervisor Mr. Albert Decady (571-272-3819). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

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PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.. Answers to questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) (toll-free (866-217-9197)).

/Albert Decady/  
Supervisory Patent Examiner  
Tech Center 2100

/Thomas H. Stevens/  
Examiner, Art Unit 2121